

## REMARKS

The thoroughness of the Final office action is noted with appreciation by applicants.

The current status of the application is as follows:

Claims 1-13, 15-31, 34 and 35 are currently pending in the subject application and are presently under consideration. The various grounds of rejections are noted as follows.

- Claims 1-10 and 22-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zenchelsky in view of Spinney further in view of Sendrowicz.
- Claims 11-13 and 15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes, in view of Spinney, further in view of Zaumen, and further in view of Sendrowicz.
- Claims 16-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes, Spinney, Zaumen and Sendrowicz, further in view of Bass.
- Claims 31 and 34-35 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes, in view of “Filters to Detect, Filters to Protect” (McLachlan, et al), hereinafter referred to as “Filters” further in view of Sendrowicz.

Before dealing with each of the rejections in the order in which they are listed above, applicants have duly noted that the examiner has combined at least three, four or even five references in order to fashion the current rejections. This in itself points to the novelty as well as the unobviousness of the present invention. Applicants submit that each successive prior art teaching when combined with the preceding reference tends to point toward the uniqueness of the claimed invention rather than its obviousness. This approach by the Office is best defined as picking and choosing only those portions of the various prior art references that support the rejection. In the case of In re Wesslau, 353 F. 2d 238 (CCPA 1965), the court held:

“It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” (emphasis original)

Similarly, in Bausch & Lomb, Inc. v. Barnes-Hind/Hydrocurve, Inc. et al, 796 F.2d 443, 230 U.S.P.Q 416 (Fed. Cir. 1986), the court held: “The ... court failed to consider the Caddell reference in its entirety and thereby ignored the portions of the reference that argued against obviousness. (citations omitted)”

Thus, it is clear that when a reference is used in a §103 citation, the entire reference must be used. One may not pick and choose from a given reference only those portions which support an espoused position, and ignore those portions which do not support that position.

#### **The Rejection of Claims 1-10 and 22-24 Under 35 U.S.C. §103(a)**

Claims 1-10 and 22-24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Zenchelsky in view of Spinney further in view of Sendrowicz. Independent claims 1, 5, 22, and 23 (from which claims 1-4, 6-10, and 24 respectively depend) were previously amended following a rejection of these claims based on the first two of these references and a telephone interview with the Examiner, in which the examiner acknowledged that the first two cited references fail to teach or suggest *using an expiration timer to age the memory, wherein the expiration timer corresponds to an expected burst interval of packets identified as being frequent flyer packets* as required by claim 22 (claims 1, 5 and 23 also recite similar aspects). Accordingly, withdrawal of this rejection is respectfully requested.

Applicants respectfully submit that the teachings of Sendrowicz fall short of overcoming the deficiencies of the teachings of the first two cited references. Sendrowicz does not teach anything about packet bursts. He does not discuss the caching in memory of predefined characteristics associated with packets for the purpose of enabling the network device to more quickly process bundles of packets that share common characteristics. The examiner’s concept of this reference as “....setting an expiration timer for a cache entry using an expected burst time of the packet” is not supported by the language of the reference. Furthermore, it does not support the language of element (g) of independent claims 1, 5 and 11. Accordingly, the addition of this reference to the rejection for obviousness should now be withdrawn, and these claims allowed.

The Federal Circuit Court has consistently held that when obviousness is based on the teachings of multiple prior art references, some “suggestion, teaching, or motivation” should be established that would lead a person of ordinary skill in the art to combine the relevant prior art teachings in the manner claimed. See for example Tec Air, Inc. v Denso Mfg. Mich. Inc., 192 F.3d 1353, 1359-60. (Fed. Cir. 1999). This criterion has been used by the Federal Circuit for the past quarter of a century, and has been consistently applied or acknowledged by numerous panels containing every currently active member of the court.

The “suggestion to combine” requirement stands as a critical safeguard against hindsight analysis and rote application of the legal test for obviousness. See Yamanouchi Pharmaceutical Co., Ltd. v. Danbury Pharacal, Inc., 231 F. 3d 1339, 1343 (Fed. Cir. 2000). By employing this safeguard, the claims in question cannot be used as a guide through plural prior art references, combining the right references in the right way so as to deny their patentability or enforceability.

Recently engrafted onto this test used by the CAFC is the Supreme Court pronouncement in KSR International Co. v. Teleflex, Inc. (Decided April 30, 2007) that the obviousness analysis should likewise consider whether one skilled in the art could implement a predictable variation to the prior art. If so, this predictability could defeat patentability under 35 USC §103. Applicants respectfully submit that the invention as now claimed does not represent a “predictable variation” of the known prior art. Thus, one skilled in the art, without knowledge of the contents of this pending application, would not likely implement such a variation without the use of sufficient inventiveness to warrant patent protection under 35 USC §103(a). Accordingly, the rejection of claims 1-10 and 22-24 based on obviousness should be withdrawn.

#### **The Rejection of Claims 11-13 and-15 Under 35 U.S.C. §103(a)**

Claims 11-15 stand rejected as being unpatentable over Hughes, in view of Spinney, further in view of Zaumen, and further in view of Sendrowicz. Independent claim 11 was previously amended in accordance with the Examiner’s suggestions, to include a limitation requiring *an expiration timer corresponds to an expected burst interval of data packets identified as frequent flyer packets*. Applicants have further distinguished their invention from the prior art by modifying this amendment to specify

that the expiration timer does not correspond to the time interval of data packets that are not thus identified. Claims 12-13 and 15 depend from claim 11 – accordingly, this rejection should be withdrawn.

Again, as with the first obviousness rejection, Sendrowicz does not supply the teachings needed to overcome the deficiencies of the first three references. Accordingly, the rejection should be withdrawn.

#### **The Rejection of Claims 16-21 Under 35 U.S.C. §103(a)**

Claims 16-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes, Spinney, and Zaumen, in view of Bass. Claims 16-21 depend from claim 11, and are believed to be allowable by virtue of their dependencies from such claim. Accordingly, the rejection should be withdrawn.

#### **The Rejection of Claims 31, 34 and 35 Under 35 U.S.C. §103(a)**

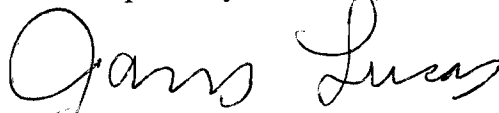
These claims stand rejected under 35 U.S.C. §103(a) as being unpatentable over Hughes, in view of Filters, further in view of the teachings of Sendrowicz. Claim 31 was amended in the last response to recite *updating contents of the cache at times that correspond to an expected burst interval of packets identified as frequency flyer packets*. This aspect is not taught or suggested by either of the first two cited references. The Sendrowicz patent does not fill the void in such a way as to be dispositive of the obviousness issue and, accordingly, claim 31 is believed to be allowable. Claims 34 and 35 depend from claim 31, and are also believed to be allowable at least by virtue of this dependency.

It is to be noted that Applicants are not conceding in this application that the claims are not patentable over the art cited by the Examiner. Instead, the present claim amendments are entered for the sole purpose of facilitating expeditious prosecution of the subject matter that is now specifically covered by the claims. Applicants respectfully reserve the right to pursue these and other claims in one or more continuation and/or divisional patent applications.

### **Conclusion**

In view of the foregoing, it is submitted that claims 1-13, 15-24, 31, 34, and 35 distinguish patentably and non-obviously over the prior art of record. An early indication of allowability is earnestly solicited.

Respectfully submitted,



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